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IN THE

Supreme Court of the United States

October Term, 1959

No. 826

COMMISSARIAT A L'ENERGIE ATOMIQUE, Assignee of Patent Applications of JEAN HENRI HALBAN, JEAN FREDERIC JOLIOT and LEW KOWARSKI, *Petitioner*,

v.

ROBERT C. WATSON, Commissioner of Patents, *Respondent*.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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ROBERT C. WATSON, Commissioner of Patents, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above-entitled case on July 20, 1959.

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals is reported at 270 F. 2d 954 and is reprinted in Appendix A hereto.

The opinion of the Court of Appeals for the District of Columbia in the closely related case of *Commissariat a l'Energie Atomique* v. *Watson*, No. 14,929 (Jan. 21, 1960), is not yet reported but is reprinted as Appendix B hereto.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 20, 1959, and a timely petition for rehearing was denied on October 30, 1959. On January 28, 1960, the Chief Justice of the United States signed an order extending the time within which to file this petition for a writ of certiorari to and including March 28, 1960. The jurisdiction of this Court is invoked under 28 U.S.C. § 1256. See discussion of jurisdiction, p. 10, *infra*.

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review on a writ of certiorari a decision of the Court of Customs and Patent Appeals finally denying a patent application.

2. Whether the Court of Customs and Patent Appeals has departed from the accepted and usual course of judicial proceedings in declining to consider or respect a decision of a Court of Appeals reopening issues which the Court of Customs and Patent Appeals considered closed under the *res judicata* doctrine.

3. Whether the Court of Customs and Patent Appeals, in resting its decision on a *res judicata* point not set forth in the "reasons of appeal", has exceeded its jurisdiction under 35 U.S.C. § 144.

4. Whether the Court of Customs and Patent Appeals, in denying a patent application dealing with a

highly important development in nuclear reaction, has misinterpreted and misapplied 35 U.S.C. § 112.

STATUTES INVOLVED

35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> * * *

35 U.S.C. § 144:

> The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the Court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

STATEMENT

This proceeding grows out of the rejection by the Patent Office of a patent application relating to nuclear reactors. The application concerns techniques that facilitate the establishment of a chain reaction of neutrons, which is the heart of a nuclear reactor. Petitioner is an official agency of the French Government and the assignee of the patent application.

Beginning in 1939, petitioner's assignors made a series of inventions on which five patent applications were filed in France and five corresponding applications were filed in each of some fifty foreign foreign countries including the United States. The pertinent applications were filed as follows:

Case	Title	French Filing	U.S. Filing
I	Device for the Production of Energy	May 1, 1939	April 5, 1940
II	Method for the Stabilization of an Energy Producing Device	May 2, 1939	April 6, 1940
IV	Improvement to Energy Producing Devices	April 30, 1940	April 30, 1946

The instant case involves the United States application on Case IV, which combines the disclosures specified in Cases I and II and discloses an improvement over those cases by substituting uranium enriched in isotope 235 for the normal uranium.

Cases I and II

Essential to an understanding of the present proceeding is a summary of the actions of the Patent Office, other governmental bodies and the courts relative to Cases I and II:

1. In November 1941 the applications were rejected by a Patent Office Examiner on the ground that the subject matter was not "sufficiently useful and important," given the then state of the art.

2. In May 1942, before the assignors' time for appeal to the Board of Appeals of the Patent Office had ex-

pired, the applications were placed under a Patent Office secrecy order and further proceedings were suspended until 1949.

3. In November 1942 the applications were vested by the Alien Property Custodian on the basis that, as a result of the German occupation of France, the owner of the applications was the government of an enemy-occupied country and hence an enemy within the meaning of Sec. 2 of the Trading With the Enemy Act. The applications continued to be owned and controlled by the Custodian until returned to the assignors in April 1954.

4. On August 1, 1946, Congress enacted the Atomic Energy Act of 1946. By the terms of that Act all information relating to nuclear reactors became restricted data, disclosure of which to unauthorized persons was made a crime. The assignors were thus prohibited from disclosing to their attorneys facts constituting restricted data, and they and their attorneys were forbidden from obtaining such data from others, in order to present such data to the Patent Office in support of the applications. This prohibition continued until some time in 1955 or later, when most information concerning nuclear reactors was declassified and made available.

5. When action on the applications was resumed in 1949, the Patent Examiner supplemented his rejection with new grounds. On November 17, 1950, the Board of Appeals affirmed the Examiner's rejections. But the Alien Property Custodian, then in control of the applications, failed to answer or refute these rejections and failed to seek judicial review of the Board's decision. The principal ground for the Board's action was that the applications did not contain a sufficient dis-

closure to enable one skilled in the art to make, construct and use the invention and, hence, did not satisfy the requirements of R. S. 4888, now 35 U. S. C. § 112.

6. In 1955, following declassification of the restricted data under the Atomic Energy Act, the assignors promptly filed petitions for reconsideration of the Board's decision and for revival of their applications, accompanying those petitions with new evidence. That new evidence established (a) that all of the physical states specified in the applications were operative, (b) that the disclosures had been reduced to practice by one of the inventors, and (c) that in the opinion of eminent scientists, the disclosures of the applications were sufficient to teach those skilled in the art how to construct an operative nuclear reactor. But the petition for reconsideration was never acted on by the Patent Office and the new evidence was never considered on its merits. The petition for revival of the applications was denied by the Commissioner on May 2, 1958.

7. On July 1, 1958, petitioner herein, as assignee of the applications, brought suit in the District Court for the District of Columbia, seeking review of the actions of the respondent Commissioner of Patents in refusing to revive, and confirming the denial of, the applications. The District Court dismissed the action.

8. On January 21, 1960, the Court of Appeals for the District of Columbia reversed in large part the action of the District Court, holding (a) that while the 60-day limit on bringing suits to review the merits of a denial of a patent application had long ago expired, 35 U. S. C. 145, the petitioner was still free to apply to the Commissioner for an extension of time

within which to bring such a suit and to reinstate the action if such an extension is granted, and (b) that the District Court had jurisdiction over the effort to secure judicial review of the Commissioner's refusal to revive the applications. The Court's decision was necessarily premised on the fact that petitioner's delay in processing the applications and the appeals from their rejections was unavoidable in the circumstances above detailed. *Commissariat a l'Energie Atomique* v. *Watson*, No. 14,929, Jan. 21, 1960, attached as Appendix B hereto.

Case IV

In the meantime, the instant application for a patent, known as Case IV, was filed in the United States on April 30, 1946. Its history may be summarized as follows:

1. In May 1947 the requested patent was held by a Patent Examiner to be prima facie barred under Section 11 of the Atomic Energy Act, which prohibited the issuance of patents directed to inventions solely useful in the production of fissionable materials. This holding was reiterated in December 1948 in response to a request for reconsideration. By reason of a failure to respond to this reiterated holding, the application was allowed to become abandoned. The Patent Office secrecy order was in effect until 1949.

2. In August 1955 petitioner filed a petition to revive and reinstate the application under Section 160 of the Atomic Energy Act of 1954. That section permitted the reinstatement of any patent application, not otherwise barred by Section 151 or Section 155 of the 1954 Act, denied by the Patent Office under Section 11 of the Atomic Energy Act of 1946, provided that the

reinstatement petition be filed within one year after enactment of the 1954 Act. If so reinstated, the patent application was to be deemed continuously pending since its original filing date.

3. In 1956 the petition to revive and reinstate was denied by the Patent Office on the ground that the application was barred by Section 155 of the 1954 Act. That section provided that "the fact that the invention or discovery was known or used before shall be a bar to the patenting of such invention or discovery, even though such prior knowledge or use was under secrecy within the Atomic Energy Program of the United States".

4. In 1957, following the filing of a petition for reconsideration and proposed amendments to the application, the Patent Office ruled that the application would be considered reinstated under Section 160 of the 1954 Act. However, the application was denied on its merits. All claims were rejected "as based upon insufficient disclosure to enable one skilled in the art to construct and use the contended invention, 35 U. S. C. 112; and as failing to disclose sufficient details of an operable reactor in which the fuel can be used, to meet the requirement of the cited statute to disclose the best mode contemplated." R. 111.

5. On July 31, 1958, the Board of Appeals affirmed the rejection of the claims on grounds of "insufficient disclosure" as stated by the Examiner. R. 163, 172.

6. On July 20, 1959, the Court of Customs and Patent Appeals affirmed the ruling of the Board of Appeals. The court held that to the extent that Case IV depended upon the disclosures in Cases I and II, "the previous final adjudications as to their insuffi-

ciency"—which adjudications had not been appealed by the then owner, the Alien Property Custodian—were *res judicata* and were conclusive as to the insufficiency of Case IV. The court further held that, without the incorporation of the previous applications, the disclosures of Case IV were insufficient under 35 U. S. C. § 112.

7. The court below, on October 30, 1959, denied a timely petition for rehearing, which specifically directed the court's attention to the appeal then pending before the Court of Appeals for the District of Columbia. It also denied petitioner's motion for leave to file copies of all briefs and the joint appendix then before the Court of Appeals.*

8. Petitioner subsequently sought to file a second petition for rehearing out of time in order to call attention to the intervening decision of the Court of Appeals for the District of Columbia in *Commissariat a l'Energie Atomique* v. *Watson*, No. 14,929, Jan. 21, 1960. Under date of March 8, 1960, the clerk of the court below wrote petitioner's counsel that the matter had been brought to the court's attention and that the following conclusion had been reached:

> "Appellants' original petition for rehearing having been denied and the mandate having gone down to the Patent Office, it does not appear that a further petition for rehearing is now in order.

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* In a letter dated Oct. 30, 1959, the clerk of the court below wrote to petitioner's counsel: "In considering the petition for rehearing the court denied the motion of appellants for leave to file copies of certain papers presently on file in the Court of Appeals for the District of Columbia in *Commissariat a l'Energie Atomique, et al.* v. *Watson et al.*, No. 14,929, and, therefore, did not incorporate the papers in the petition for rehearing as filed in this court."

It may be noted, moreover, that the correctness of the Patent Office decision on the issue of *res judicata* must be determined on the basis of the circumstances as they were at the time when that decision was made rather than as they are now, *In re Isler*, 33 CCPA 791, 152 F. 2d 1002, 68 USPQ 198. It does not appear, therefore, that the decision of the United States Court of Appeals for the District of Columbia Circuit, dated January 21, 1960, in *Commissariat a l'Energie Atomique, et al.* v. *Watson, et al.*, No. 14,929, could properly be made the basis for any modification of this court's decision."

JURISDICTION

At the outset of this case is an important and unresolved question as to this Court's jurisdiction to review this or any patent case decided by the Court of Customs and Patent Appeals.

In a series of cases beginning with *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U. S. 693, this Court has held that neither patent nor trademark decisions of the nature now determined by the Court of Customs and Patent Appeals are reviewable in this Court. See also *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U. S. 858 (a trademark case); *McBride* v. *Teeple*, 311 U. S. 649 (a patent case). The following reasons have been given: (1) since the Court of Customs and Patent Appeals decisions do not have a binding effect on the question of trademark or patent validity, they are not of such nature as to be reviewable by this Court under its Article III jurisdiction; (2) the Court of Customs and Patent Appeals proceedings are administrative in nature and are not "cases" or "controversies" within the meaning of Article III; and (3) the absence of any statutory au-

thorization for review of such proceedings by this Court.

Petitioner submits that all of the foregoing reasons have either disappeared or are inapplicable to this case and that this Court possesses full power to review the decision below.

(1) In this case, the Court of Customs and Patent Appeals determined that a patent should be denied and hence there is nothing the validity of which can be called into question in another court at another time. Moreover, in *Hoover Co.* v. *Coe*, 325 U. S. 79, and in *Special Equipment Co.* v. *Coe*, 324 U. S. 370, this Court granted full review of District Court patent proceedings even though the District Court judgments had no more binding effect on the issue of validity than do judgments of the Court of Customs and Patent Appeals. These two subsequent decisions indicate an abandonment of the no-binding-judgment argument advanced in the *Postum* case. See Robertson and Kirkham, Jurisdiction of the Supreme Court of the United States (Wolfson and Kurland ed.) § 251, pp. 442-448; Gilbert, The Constitutionality of Supreme Court Review of Patent and Trademark Decisions of the Court of Customs and Patent Appeals, 45 Geo. L. J. 645, 48 T.M.R. 8.

(2) The decisions of the Court of Customs and Patent Appeals can no longer be considered as administrative in nature. That tribunal in 1958 was accorded the status of "a court established under article III of the Constitution of the United States," 72 Stat. 848, 28 U. S. C. § 211, and its judgments must be considered to be judicial pronouncements on cases and controversies. The parties before it act in a truly adversary capacity and the court interprets and applies the legis-

lative standards prescribed by Congress in rendering its decisions.

(3) This Court now has full and unconditional statutory authority to review any and all decisions of the Court of Customs and Patent Appeals. The 1948 recodification of the Judicial Code plainly states: "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari." 28 U. S. C. § 1256.* This unambiguous provision indicates no legislative intent to confine review to any particular type of case or to exclude either patent or trademark cases.

The foregoing factors combine to make evident the existence of jurisdiction in this Court to review the judgment below.

REASONS FOR GRANTING THE WRIT

1. The decision below raises an important question of judicial administration

An obviously important question raised by the decision below is the extent to which the Court of Customs and Patent Appeals is bound to respect the jurisdiction and decisions of coordinate federal courts in passing upon patentability issues relevant to the case before it.

As a constitutional court under Article III of the Constitution, so designated by Congress in 28 U. S. C. § 211, the Court of Customs and Patent Appeals is a part of the federal judicial system. It is

* Rule 19 of this Court's rules provides that the same general considerations governing review of decisions of the Courts of Appeals "will control in respect of petitions for writs of certiorari to review judgments of the Court of Claims, of the Court of Customs and Patent Appeals, or of any other court whose determinations are by law reviewable on writ of certiorari."

bound to have scrupulous regard "for the smooth working of the federal judiciary," *Railroad Commission* v. *Pullman Co.*, 312 U. S. 496, 501, so as not to create confusion and inconsistency in the judicial supervision of the patent laws of the United States.

But by a knowing disregard for the pendency and resolution of a closely related case in the Court of Appeals for the District of Columbia, the court below has created just such confusion and inconsistency. At the very core of the decision below is the holding that the reliance of the instant patent application upon the two prior disclosures in Cases I and II is inadequate "because of the previous final adjudications as to their insufficiencies." Such prior adjudications were rendered by the Board of Appeals of the Patent Office, it being emphasized that "no appeals were taken therefrom nor appropriate action had before the District Court for the District of Columbia." The conclusion was accordingly reached that those so-called final adjudications were *res judicata* and "binding upon this court," foreclosing attack "in a subsequent proceeding" such as this.

The great deference thus paid to the Board of Appeals rulings is in sharp contrast to the refusal to acknowledge or accommodate the institution of appropriate proceedings in the District Court for the District of Columbia and the subsequent appeal proceedings in the Court of Appeals for the District of Columbia. Those proceedings resulted in the destruction of the finality of the Board of Appeals rulings and reopened the basic questions as to the sufficiencies of the disclosures in Cases I and II. In the closely allied case of *Commissariat a l'Energie Atomique* v. *Watson*, No. 14,929, the Court of Appeals ruled that petitioner,

even at this late date, has the right to seek an extension of time in which to bring suit for a direct judicial review of the Board of Appeals rulings, as well as the right to secure review of the Commissioner's refusal to revive the applications.

The existence and pendency of the District of Columbia proceedings were brought to the attention of the court below at every appropriate juncture. In petitioner's original brief before the court below (p. 46, note 24) and in the petition for rehearing (pp. 7-12), the nature and pendency of the Court of Appeals proceedings were fully explained. Leave to file copies of all briefs and the joint appendix in the Court of Appeals was denied by the court below. And when petitioner sought to direct attention to the subsequent ruling of the Court of Appeals by means of a second petition for rehearing, the court below indicated the petition would not be received.

In these circumstances, a substantial question is raised as to the duty of Court of Customs and Patent Appeals to respect a directly relevant ruling of the Court of Appeals for the District of Columbia. That ruling undercut the essential basis of the holding of the court below. What is final in the Court of Customs and Patent Appeals is not final in the Court of Appeals. And if the Court of Appeals ruling eventuates in a reopening of Cases I and II and a determination of adequacy of their disclosures, petitioner will lose all the benefit of such a determination as respects Case IV unless the decision below is reversed. Indeed, there may be a serious question whether the Patent Office can give effect to the decision of the Court of Appeals for the District of Columbia as long as the decision of the court below, according finality to the

Patent Office actions in Cases I and II, remains in effect. Only confusion and injustice can result from that state of affairs, thus making appropriate the exercise of this Court's certiorari jurisdiction to correct this departure from the accepted and usual course of judicial proceedings.

2. The decision below raises an important question as to its consistency with the requirements of 35 U.S.C. § 144

An important question is also raised as to whether the Court of Customs and Patent Appeals, in resting its decision upon doctrines of *res judicata*, has acted in contravention of 35 U. S. C. § 144. That provision of law contains a Congressional mandate that the decision of the Court of Customs and Patent Appeals in patent matters shall be based "on the evidence produced before the Patent Office" and "shall be confined to the points set forth in the reasons of appeal." This latter requirement has consistently been recognized as jurisdictional in nature. Unless a question is set forth in the formal reasons of appeal, the court has no jurisdiction to consider the question. *In re Sebald*, 143 F. 2d 366, 31 C.C.P.A. 1148; *In re Savage*, 110 F. 2d 680, 27 C.C.P.A. 1048. And it is equally clear that the court will not consider grounds of rejection of a patent application which were not relied upon by either the Examiner or the Board of Appeals. *In re Franck*, 255 F. 2d 931, 45 C.C.P.A. 975; *In re Kelly*, 230 F. 2d 435, 43 C.C.P.A. 816.

In the instant case, the court below conceded that "the Board of Appeals, in its decision here on review, did not specifically refer to the effect of the earlier decisions relative to U. S. I and II." And by reason of the absence of such a reference, petitioner's "reasons

of appeal" filed in the court below, R. 207-209, presented no question or point as to the *res judicata* effect of the prior determinations. That point was neither argued nor briefed by any party before the court below. Thus under 35 U. S. C. § 144, the court lacked jurisdiction to consider such a point.

In seeking to justify consideration of an issue outside its jurisdiction, the court below referred to the answer filed by the Examiner in the Board of Appeals proceedings, wherein the Examiner alluded in passing to the prior adjudications of the Board in Cases I and II and the *res judicata* effect thereof.[1] Such a statement was obviously not meant to constitute an independent ground of rejection. The precise grounds of the final rejection were set forth by the Examiner in his letter dated July 9, 1957, R. 105-111, and included no mention of the *res judicata* matter. More importantly, the decision of the Board of Appeals contains no reference to the *res judicata* doctrine, R. 163-172. And hence the "reasons of appeal" to

[1] The Examiner's Answer stated (R. 152): "It is also noteworthy that the applications referred to were abandoned after adverse decisions of the Board of Appeals, affirming rejections on the ground that they contained insufficient disclosure. Applicants seek to avoid the holding of *res judicata* as to insufficiency of disclosure in those cases by pointing out that the applications were at the time vested by the Alien Property Custodian and charging that they were thus being prosecuted by a party adverse to applicants. Since applicants were nationals of an occupied country, rather than an enemy country, it is submitted that the Alien Property Custodian was not an adverse party but was in the character of a protector of applicants' property and that his action in prosecuting the applications to appeal was in fact in applicants' interest. Mere change in ownership or control of an application subsequent to an adverse decision acquiesced in, is not normally regarded as removing the stigma of *res judicata* in any event."

the court below omitted any allegation or question as to the previous determinations.[2]

Thus petitioner never had notice that *res judicata* was being relied on by the Patent Office as a ground of rejection or even that it was being urged before the court below. No evidence was introduced into the record as to the circumstances surrounding the prior determinations and no opportunity was afforded petitioner in this respect "to know the claims of the opposing party and to meet them." *Morgan* v. *United States*, 304 U. S. 1.

Reliance on *res judicata* by the court below violated procedural due process and the express limitation of 35 U. S. C. § 144. Such action calls for the invocation of this Court's review powers.

3. The decision below raised important questions as to the adequacy of the disclosures of a highly significant patent application

The disclosures involved in Case IV relate to one of the greatest technical developments in the history of man—the extraction of atomic energy for industrial use without producing a destructive explosion. The

[2] In petitioner's brief in the court below it was said (p. 46, note 24): "In the Examiner's Answer, the Examiner in passing alluded to prior decisions of the Board of Appeals in appellants' parent applications U.S. Cases I and II. However, appellants do not, and the Board did not, consider this to be a separate ground of rejection. Petitions to revive U.S. Cases I and II under 35 U.S.C. 133 were denied by the Patent Office, whose decision was upheld by the U.S. District Court for the District of Columbia. The decision of that Court is now on appeal to the U.S. Court of Appeals for the District of Columbia Circuit."

At no time did the Commissioner intimate any disagreement with petitioner's understanding, as thus expressed, that *res judicata* had not been relied upon in the Patent Office's rejection.

invention set forth in the application was developed by three of the world's eminent scientists, one of them a Nobel prize winner. Clearly, the question as to the merits of this application is of great public and indeed international importance.

Prior to this invention it was known that a uranimu nucleus will split when bombarded with neutrons, that this fission results in the liberation of large amounts of energy and the release of new neutrons, that fission is more apt to occur if a moderator is used to slow down the neutron speed, and that certain materials such as cadmium would absorb neutrons. But the claimed invention does not exist in the foregoing scientific principles. Rather it consists in the utilization of those principles in combination to accomplish a practical result—i.e., the production of heat energy. If the nuclear reaction is made to occur in the manner specified in the application it will be possible to extract energy and use it for industrial, peaceful purposes.

What the application known as Case IV claims is a method and a device to use known scientific principles to accomplish a useful result. Specifically, the application, when considered in conjunction with the applications in Cases I and II, discloses (1) the use of a limited mass of uranium, (2) a means of reducing the velocity of the liberated neutrons by use of a moderator—i.e., introduction "inside the mass of uranium" of an element of low atomic weight such as hydrogen or oxygen, (3) an absorbing element to absorb neutrons at an increasing rate as temperature increases, (4) an optional reflecting envelope surrounding the device to decrease the critical mass by reducing the escape of neutrons, (5) a further detailed method of controlling the reaction by periodically

starting and interrupting it, and (6) a means of increasing the efficiency of the device by using uranium enriched in the isotope 235, thereby reducing the critical mass. All of these elements together constitute the essentials of a nuclear reactor. R. 417, 383, 358.

The majority opinion of the court below does not deny that if the applications in Cases I, II and IV are read together to produce the foregoing disclosures a patentable invention would be revealed. The court found a lack of adequate disclosures only by reading out of the Case IV disclosures the disclosures of Cases I and II. And they were read out by the process of invoking the *res judicata* doctrine. To deny the petitioner a patent on such a basis, where the disclosures are not otherwise found to be inadequate, is to abuse the principles of the patent system.

Any implication in the opinion below that the invention must *necessarily* be operable is dispelled by the court's own decision in *In re Chilowsky*, 229 F. 2d 457, 461; 43 C.C.P.A. 775, where it was held that in the nuclear field "[t]he mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it." It is enough to show, as this application did, that the device will probably be operable. Indeed, the assignors successfully demonstrated their device in December 1940 and no question has been raised as to the sufficiency or convincing nature of that demonstration, considering the shortage of materials and other war-time restrictions then in effect.

The *Chilowsky* case also makes clear the impropriety of any further implication in the opinion that a patent may be denied on a general conclusion that nothing in

the application teaches one skilled in the art how to proceed. Only specific, detailed objections, as to which the applicant has full opportunity to refute, can serve to justify a rejection. Moreover, the record here shows unequivocal opinions of responsible and eminent scientists[3] that the combined disclosures in Case IV are sufficient to have taught the nuclear scientist of 1939 and 1940 how to construct and operate a pioneer nuclear reactor.

Under these facts of record, the opinion below rejecting the appeal cannot stand under the standards set forth in 35 U. S. C. § 112. And so important is the device in the international community that direct review of the issue by this Court is appropriate.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari to the Court of Customs and Patent Appeals should be granted.

Respectfully submitted,

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[3] Affidavits of (1) Dr. Harold Urey, Nobel prize winner, R. 283, (2) Prof. Rocard, member of the French Atomic Energy Commission and Director of the Laboratory of Physics of the University of Paris, R. 358, and (3) Jacques Yvon, Director of Department of Pile Studies of the French Atomic Energy Commission, R. 426-7.

APPENDIX

APPENDIX

APPENDIX A

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
OCTOBER TERM, 1958.

Patent Appeal No. 6514.

Patent Calendar No. 141.

Serial No. 666,183.

In the Matter of the Application of

JEAN FREDERIC JOLIOT, JEAN HENRI HALBAN, and LEW KOWARSKI

MARTIN, Judge.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office, dated July 31, 1958, affirming the rejection of claims 5, 6 and 8, all the claims remaining in appellants's application for a patent, Serial No. 666,183, filed April 30, 1946, relating to "Improvements in and Relating to the Production of Energy through Nuclear Fission." Priority, based on an application filed in France on April 30, 1940, is claimed under the Boykin Act (Public Law 690, 79th Congress).

Claims 6 and 8, illustrative of the appealed claims, appear as follows:

> 6. A method for the improvement of the efficiency of methods and devices for the production of energy through nuclear fission of uranium, by means of a divergent chain reaction of neutrons, said method consisting in making use, for the reaction, of the uranium element in a form in which the proportion of isotope 235 is about five times that of the said isotope in normally obtained uranium and the slowing down element is heavy water.

8. In a device for the production of energy through nuclear fission of uranium essentially formed of a mass of uranium susceptible to give rise under the action of neutrons to an emission of neutrons in a chain, the said mass being enclosed in a neutron reflecting envelope and comprising in its midst, an element for slowing down the neutrons and part at least of said neutrons to approximate thermal equilibrium with the mass, said element being in an amount less than that which hinders unlimited development of chain in a divergent geometric progression, and a further element absorbing the slowed down neutrons in a proportion which becomes higher with respect to the absorption by the uranium when the temperature rises, wherein the uranium used contains a proportion of isotope-235 of uranium higher than that existing in uranium as found in nature.

The invention allegedly disclosed in this application pertains to means for increasing the efficiency of nuclear reactors and chain reaction processes producing energy by the fission of uranium nuclei, the means consisting in the provision of a uranium fuel which has been enriched in the proportion of uranium isotope 235, as compared with that ordinarily obtained. Such enrichment is said to create conditions favorable to the propagation of a diverging or self-sustaining chain reaction, which facilitates the continuous production of energy for industrial or military purposes.

The materials disclosed in the application here on appeal are said to be useful in combination with the "dispositions" shown in certain other of appellants' applications, referred to in blank in the specification here in issue. Appellants assert that the disclosures of prior copending United States applications Serial No. 328,160 and Serial No. 328,373; hereinafter referred to as U.S. I and U.S. II,

respectively, were intended by such blank reference and should be incorporated with the disclosure of the application on appeal in assaying its sufficiency.

The U.S. I application provides for a device for the production of energy (a nuclear reactor) including a mass of uranium fuel and certain elements intended to control the rate of energy liberation to avoid the possibility of explosion. Such latter elements comprise absorber and moderator materials, designed, respectively, to absorb and slow down the neutrons which propogate the chain reaction. The complete system referred to above is enclosed in a "diffusing" or reflecting "envelope" in order to prevent the escape of the neutrons emitted by nuclear fission. The diverging chain reaction is said to occur only when the reacting mass exceeds a certain threshold quantity, termed the critical mass. This mass is dependent upon the relative amounts of the components of the reacting system and the relative probabilities of neutron release from a fissionable nucleus. While no quantities of fuel, absorber or moderator materials are disclosed in this application, the specification avers that "since science presently has at its disposal means for measuring the multiplication of neutrons, it will be easy to estimate the value of the critical mass by progressive experiments."

The U.S. II application discloses several alternative means for controlling the chain reaction by interruptions thereof comprising periodic introduction or removal from the device of fissionable material or absorber material or periodic approach and separation of parts of the uranium mass. Additionally, this application suggests periodic disengagement of the external reflecting envelope as a reaction control mechanism.

These prior filed applications, while vested in, and hence under the control of, the Alien Property Custodian, were rejected on the ground that they did not contain disclosures

sufficient to satisfy the requirements of R. S. 4888.[1] Those rejections were affirmed by the Board of Appeals and no appeals were taken therefrom nor appropriate action had before the District Court for the District of Columbia.

All the claims here on appeal have been rejected on the ground that the specification of the present application, together with the disclosures of U.S. I and II, is insufficient to teach those skilled in the art how to make and use the invention, as required by 35 U.S.C. 112, which, in 1953, replaced R.S. 4888. Other grounds of rejection have been made, but in the view we take of the case, it is unnecessary to consider more than the one above mentioned.

Appellants have here predicated their contention of patentability of claims 5 and 8 entirely, and claim 6 alternatively, upon the incorporation of the disclosures of U.S. I and II into the application on appeal. They rely on the disclosures of the previous applications as the means of showing the operability of the invention described and claimed in the present application. The instant

[1] R.S. 4888. *Application for patent; description; specification and claim.*

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.

application discloses only the use of an enriched fuel source and refers to the prior filed applications for disclosure of the devices and methods in which such fuel shall be utilized.

Assuming, arguendo, that the disclosures of U.S. I and U.S. II may be properly incorporated in the disclosure of the application on appeal by the reference in blank therein, the two prior disclosures here involved cannot be used to introduce an operative disclosure because of the previous final adjudications as to their insufficiency. While in certain situations a plurality of disclosures may, like pieces of a jigsaw puzzle fitted together, create a new composite disclosure raising a distinctly different issue of sufficiency, wherein the prior applications, although adjudicated, might be considered on their merits, such is not the present case. The disclosures of U. S. I and II in no sense create a new combination with each other or with the disclosure of the instant application, but in reality, if they could do anything, they alone could provide the only possible disclosure to support the contention that an operable invention has been disclosed.

While the wording of the section of the Patent Act of 1952 corresponding to R. S. 4888, viz. 35 U.S.C. 112,[2] is

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[2] § 112. *Specification.*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combinaton may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such

not identical therewith, there is no material difference between the two provisions with respect to the requirement pertaining to the sufficiency of disclosure of an application. Consequently, a final holding that a disclosure is insufficient to comply with R. S. 4888 necessarily involves a holding of insufficiency under 35 U.S.C. 112, and the prior adjudications as to the insufficiency of disclosure of U.S. applications I or II are, therefore, binding upon this court.

Under circumstances similar to those here involved, this court and the Court of Appeals for the District of Columbia have held that a final holding of insufficiency of disclosure cannot be attacked in a subsequent proceeding. *Lavin* v. *Pierotti*, 29 CCPA 1235, 129 F. 2d 883, 54 USPQ 400; *Whittier* v. *Borchardt*, 33 CCPA 1023, 154 F. 2d 522, 69 USPQ 382; *Hemphill Company* v. *Coe*, 74 App. D.C. 123, 121 F. 2d 897, 49 USPQ 484.

Although the Board of Appeals, in its decision here on review, did not specifically refer to the effect of the earlier decisions relative to U.S. I and II, it did affirm the examiner's rejection "* * * for the reasons stated by him in his answer * * *." Such answer clearly noted that the determination of the sufficiency of disclosure U.S. I and II was foreclosed by the prior adjudications.

Appellants' response before the examiner, to the application of the principle of *res judicata* in this case as to the sufficiency of U.S. I and II was that the two previous applications were improperly prosecuted by the Alien Property Custodian and that, therefore, appellants should not be bound by the adjudications of those applications. If we were to follow appellants' contention, every patent application prosecuted by the Alien Property Custodian

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claim shall be construed to cover the corresponding structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

and every other action taken by this official would be in perpetual jeopardy, which would be intolerable. The Alien Property Custodian was the vested owner of the applications at the time of the prior judgments and his actions with respect thereto are therefore binding on appellants, who are his successors in title.

The specification of the pending application alone, without the incorporation of the previous applications, clearly does not comply with the provisions of 35 U.S.C. 112. In other words, there is no statement in the pending application "of the manner and process of making and using it [the invention], in such full, clear, concise, and exact terms as to enable any person skilled in the art * * * to make and use the same * * *." There is a recitation of the "known" method to "ensure with certainty the propagation of the fissions" by interposing "on the path of the new neutrons emitted and before their eventual meeting points with new uranium nuclei, one or more light or very light elements such as, for instance, hydrogen which may be in the form of water, or deuterium * * *." Further, there is a statement that the use of uranium enriched in isotope 235 may be obtained through any known means, for instance by thermic diffusion." There is nothing in the specification to teach one skilled in the art how to bring about these desired results. Without the benefit of the disclosures of the two previous applications, the pending application merely states what was allegedly known in the art, and that better results may be obtained by the use of enriched uranium. The specification is entirely devoid of any recitation of methods or means of making the alleged invention operable. In view of the above, we do not believe that the specification of the pending application contains an operative disclosure.

Appellants urge that even though the pending application alone might not support claims 5 and 8, its disclosure does support claim [illegible]. We find nothing in the specification

to sustain this contention. Even though claim 6 recites a method for the improvement of the production of energy through nuclear fission of uranium by means of a divergent chain reaction of neutrons, using uranium enriched in isotope 235, there is nothing in the specification which would teach one skilled in the art how to proceed. The specification merely recites the results of the use of the enriched uranium without specifying the means to attain these results.

It should be noted that the affidavits of the renowned nuclear physicists introduced by appellants fail to state that the disclosure of the instant application alone would teach the affiants or others skilled in the art to use the method set forth in claim 6, or as a matter of fact, to use the method set forth in claim 5 or to make the device set forth in claim 8.

In view of the foregoing, it is unnecessary to discuss the other contentions of the appellants. The decision of the Board of Appeals is *affirmed*.

AFFIRMED

WORLEY, C.J., did not participate in this decision because of illness.

July 20, 1959.

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
OCTOBER TERM, 1958.

Patent Appeal No. 6514.

Patent Calendar No. 141.

Serial No. 666,183.

In the Matter of the Application of

JEAN FREDERIC JOLIOT, JEAN HENRI HALBAN, and LEW KOWARSKI

RICH, Judge, concurring:

While I fully agree with the grounds of the decision in Judge Martin's opinion, I would like to go a little further and make the observation that the patent statutes do not authorize the grant of patents on theories but only on useful inventions—concrete contributions to the "useful arts" referred to in the Constitution, Art. 1, section 8. Appellants have attempted to obtain patents in the categories of "process" and "machine," 35 U.S.C. 101, without disclosing in their applications a single specific process or machine. A study of the application on appeal and the two earlier applications attempted to be incorporated therein reveals only theoretical considerations, including a plurality of alternatives, which, if pursued with the aid of an uncertain but surely extensive amount of further experimentation, might lead to the development of an operative process or reactor for the production of nuclear energy.

Meritorious though the scientific principles disclosed may be, and regardless of how much they may reveal to other workers in the field, they fall short of the point which must be reached to entitle one to a patent. That point is not reached until it is possible to comply with the provision in section 112 of the statute that the patent applica-

tion disclose the manner and process of making and using the machine or the process "in such *full, clear, concise and exact* terms as to enable any person skilled in the art to which it pertains" to make and use *the machine*, or use *the process*, alleged to have been invented. These are exacting requirements and the need for compliance with them is one of the fundamentals of the patent system.

This might be a good time to point out that the purpose of the patent system is to promote the progress of the *useful* arts, which is done by granting patents for completed inventions. They may be crude but they must have been carried to the point where they work. Merely propounding the theories according to which they must be made in order to work is not enough. It might also be well to note that, as pointed out in the House and Senate reports on the bill which became the Patent Act of 1952 (82nd Cong., House Report No. 1923, May 12, 1952, p. 4; Senate Report No. 1979, June 27, 1952, p. 3, to accompany H.R. 7794), it is quite unlikely that the authors of the Constitution had patents, inventors or inventions in mind when in Art. 1, section 8 they referred to "science." What we now know as "science" did not exist when the Constitution was written. Such "science" as existed was more likely to be called natural philosophy and the probability is that "science" in the Constitution referred to knowledge in general, which was to be promoted by Congress, should it choose to exercise its power, by "securing for limited times to authors * * * the exclusive right to their * * * writings." See Karl B. Lutz, "Patents and Science," 18 Geo. Wash. L. Rev. 50, 32 J.P.O.S. 83, Feb. 1950. Thus there was no implication that patents were to be granted for scientific discoveries, or hypotheses, but only to inventors for their discoveries in useful arts. Hence the statutory requirement that something of use in the useful arts must be produced and the correlative requirement that it must be fully disclosed so that those in the art can use it.

Put in another way, the statutes do not provide for the granting of patents on all *inventions*, which term could conceivably include the discovery of scientific facts or the invention of theories, but only for patenting operative processes, machines, manufactures, compositions of matter and improvements thereof as accomplished facts, not mere proposals.

The record here shows that the useful arts waited a long time and for a vast amount of work to be done subsequent to appellants' application disclosures before a useful nuclear reactor or process of producing nuclear energy, for industrial purposes, came into being. It is for accomplishments of this sort that patents are granted, and then provided only that there is a disclosure of how to achieve them.

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 14,929

COMMISSARIAT A L'ENERGIE ATOMIQUE, ET AL., APPELLANTS,

v.

ROBERT C. WATSON, Commissioner of Patents, et al., APPELLEES.

Appeal from the United States District Court
for the District of Columbia

Decided January 21, 1960

Mr. James L. Morrisson for appellants.

Mr. Joseph Schimmel, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellees.

Before EDGERTON, BAZELON and WASHINGTON, Circuit Judges.

WASHINGTON, *Circuit Judge:* This is a patent case. Appellants (plaintiffs below) appeal from a decision of the District Court granting appellees' motion to dismiss appellants' complaint on the ground that it failed to state a cause of action and that the court lacked jurisdiction over the subject matter.

Appellants' complaint sought to review the refusal of the Commissioner of Patents to revive an application for a patent covering certain processes for the production of nuclear energy, and the refusal of the Board of Appeals of the Patent Office to reconsider its affirm-

ance on November 17, 1950, of the Patent Examiner's original denial of the patent. Both the request for revival and the request for reconsideration were founded on alleged new evidence which would, appellants claimed, have shown that a patent should have been granted. In asking the District Court to review the denials of these requests to revive and reconsider, appellants maintained that the District Court had jurisdiction with respect to the revival decision because the Commissioner failed to make findings in accordance with Section 133 of Title 35, U. S. Code (1958).[1] It was asserted that these omissions involved failure to exercise the discretion required by statute and were reviewable in the District Court by writ of mandamus. With respect to the Board of Appeals' refusal to reconsider, appellants asserted that denial of this request constituted a final decision on the merits of a patent application which was reviewable by the District Court under Section 145 of Title 35, U. S. Code (1958).[2]

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[1] Section 133 provides as follows:

"Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable."

[2] Section 145 provides in pertinent part:

"An applicant dissatisfied with the decision of the Board of Appeals may . . . have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. . . ."

The background, in brief, is this: On April 5, 1940, appellants—members of an agency of the French Government—applied for a United States patent on an apparatus for the production of energy by a nuclear chain reaction. The Patent Examiner rejected the application on November 8, 1941, because the subject matter was not "sufficiently useful and important," given the then state of the art. On May 5, 1942—before appellants' time for appeal to the Board of Appeals had expired—the application was placed under a Patent Office secrecy order and further proceedings were suspended until 1949. During this interval the application was vested in the Alien Property Custodian, and appellants claim that evidence which was relevant to the application was put under additional secrecy restrictions by the passage of the Atomic Energy Act of 1946, 60 Stat. 755, 42 U.S.C. §§ 1801-19 (1952). In 1949, while the application was still controlled by the Alien Property Custodian, and while the allegedly relevant information was still (according to appellants) under Atomic Energy Act secrecy restraints, the Patent Office lifted its secrecy order and resumed proceedings. On November 17, 1950, the Board of Appeals affirmed the Examiner's rejection of the application. For some time, no further action was taken by anyone. In 1954, the application was returned to appellants by the Alien Property Custodian. Appellants did not proceed immediately in the Patent Office, but waited until August 29, 1955, by which time, they claim, sufficient data restricted under the Atomic Energy Act had been declassified so that they could, for the first time, disprove the findings of the Patent Examiner and Board of Appeals. On that date appellants petitioned the Commissioner to revive their application, invoking Section 133 of Title 35 of the United States Code. The petition was denied on July 10, 1956, and requests for reconsideration were denied on February 26, 1957, July 15, 1957, February 14, 1958, and May 2, 1958. Appel-

lants filed their complaint in the District Court on July 1, 1958, and the proceedings in that court led to this appeal.

It is clear that at the time appellants' complaint was filed the District Court had no jurisdiction to consider the merits of the patent application under Section 145 of Title 35, U. S. Code. Section 145 requires complaints to be filed in the District Court "within such time after . . . [the Board's] decision, not less than sixty days, as the Commissioner appoints." The Commissioner has appointed sixty days.[3] Whatever effect may be given to the fact that the application was vested in the Alien Property Custodian at the time of the Board's decision, much more than sixty days elapsed between the date of the return of the application to appellants and their filing of a complaint in the District Court. The time for bringing suit under Section 145 has thus long since run. There is nothing to indicate that appellants have ever made application to the Commissioner for an extension of time within which to bring suit. See *Grady* v. *Watson*, 104 U.S.App.D.C. 286, 261 F.2d 752 (1958); *Eckey* v. *Watson*, —— U.S.App.D.C. ——, 268 F.2d 891 (1959). The dismissal of the complaint insofar as its seeks relief under Section 145 will accordingly be affirmed, without prejudice to the making of an appropriate application to the Commissioner under the rule of the *Eckey* case, and without prejudice to such proceedings for reinstatement of the complaint as may be proper in the event the Commissioner grants the application.

However, with respect to the Commissioner's refusal to revive the application, after request made under Section 133 of Title 35, we think that appellants' complaint states a cause of action over which the District Court had jurisdiction. Section 133, impliedly permitting the Commissioner to revive a patent application, requires an

[3] Rule 304, Rules of Practice of the U. S. Patent Office in Patent Cases.

applicant to show "to the satisfaction of the Commissioner that . . . . delay [in prosecuting the application] was unavoidable": otherwise, the application "shall be regarded as abandoned." True, in the days when appeals from decisions of the Commissioner were taken directly to the Court of Appeals of the District of Columbia, it was held that the then governing statutes did not authorize an appeal from a decision denying revival of an application. *In re Carvalho*, 47 App.D.C. 584 (1918). Later, in a case where suit was brought in the Supreme Court of the District of Columbia under Section 4915 of the Revised Statutes (the predecessor of Section 145 of Title 35), it was held that the Commissioner's refusal to revive an application was not cognizable in such a suit. *Chessin* v. *Robertson*, 61 App.D.C. 376, 63 F.2d 267, cert. denied, 289 U.S. 725 (1933). A like decision was rendered in *Cregier* v. *Coe*, 62 App.D.C. 320, 67 F.2d 692 (1933), cert. denied, 291U.S. 683 (1934). We have no quarrel with those holdings. As the court pointed out in the *Cregier* case, "The denial of a motion to revive an application is not equivalent to the refusal to grant a patent," and such refusal is the sole basis for a suit under Section 4915.[4] *Id.* at 321, 67 F.2d at 693. Dicta may be found in *Chessin* and *Cregier* that a denial by the Commissioner of a request for revival "is not subject to judicial review." But this cannot mean that mandamus will never lie to correct an arbitrary or capricious action by the Commissioner in respect of a request for revival.

The Commissioner doubtless possesses a large measure of discretion in matters of this sort. The statute does not, however, purport to make that discretion plenary and unreviewable; it speaks of a showing "to the satisfaction of the Commissioner." Many years ago the Supreme Court construed similar language in a statute which pro-

[4] Or its successor, Section 145 of Title 35.

vided that "where it shall appear to the satisfaction of the Secretary of the Interior" that excessive payments had been made to the Government, the "excess shall be repaid." The Court emphatically denied that this provision allowed the Secretary to refuse repayment in his "uncontrolled judgment and discretion," where the facts were not in dispute and where as a matter of law a debt existed. *United States* v. *Laughlin*, 249 U.S. 440 (1919). Similarly, in cases like the present, where valuable rights are at stake, the Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense. No doubt the courts should be and will be extremely reluctant to disturb the Commissioner's decision in a matter of this sort.[5] But jurisdiction exists, though the occasion for its exercise may only rarely arise.

Appellants further allege that they requested, but did not receive, "specific findings of fact setting forth the basis for . . . [the Commissioner's] determination"[6] that the application for revival should be denied. Although Section 133 does not require an affirmative finding that the delay was avoidable, the Commissioner should tell the applicant—at least if a timely request for findings is made, as appellants here claim—why his plea was unavailing, in order to provide an adequate basis for judicial review. Under comparable circumstances, we

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[5] See, on the general probelm, DAVIS, ADMINISTRATIVE LAW 842-67 (1951).

[6] The complaint says:

> "In a petition for reconsideration addressed to defendant Crocker, plaintiffs requested a specific determination whether the delay in further prosecuting the application was avoidable or unavoidable, and requested specific findings of fact setting forth the basis for that determination. This request was ignored."

have held that the courts may require the making of explicit findings. See *Coffey* v. *Jordan*, —— U.S.App. D.C. ——, —— F.2d —— (1959). Such findings are particularly necessary where, as here, appellants also allege their ability to prove facts (set forth in the complaint and certainly not of obviously frivolous character) which they say would cause the Commissioner, in the proper exercise of his discretion, to hold in their favor. Cf. *Greensboro-High Point Airport Authority* v. *Civil Aeronautics Board*, 97 U.S.App.D.C. 358, 231 F.2d 517 (1956).

For these reasons, we hold that the complaint's prayer for mandamus, and its attendant request for findings of fact, stated a cause of action over which the District Court should have exercised jurisdiction. The judgment of the District Court will be reversed with respect to this aspect of the complaint, and the cause will be remanded for further proceedings not inconsistent with this opinion. See *Joint Anti-Fascist Refugee Committee* v. *McGrath*, 341 U.S. 123, 142 (1951). Inasmuch as the Patent Office has not filed an answer, but has simply filed a motion to dismiss, the Commissioner should be given a reasonable time to submit findings on a voluntary basis, and/or to file an answer to the allegations of the complaint, or take other appropriate action, as he may be advised.

The judgment of the District Court will be affirmed in part and reversed in part, and the cause remanded for further proceedings.

So ordered.

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No. 826

In the Supreme Court of the United States

OCTOBER TERM, 1959

COMMISSARIAT A L'ENERGIE ATOMIQUE, Assignee of Patent Applications of JEAN HENRI HALBAN, JEAN FREDERIC JOLIOT and LEW KOWARSKI, PETITIONER

v.

ROBERT C. WATSON, Commissioner of Patents

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

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In the Supreme Court of the United States

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COMMISSARIAT A L'ENERGIE ATOMIQUE, Assignee of Patent Applications of JEAN HENRI HALBAN, JEAN FRÉDERIC JOLIOT and LEW KOWARSKI, PETITIONER

v.

ROBERT C. WATSON, Commissioner of Patents

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinions of the United States Court of Customs and Patent Appeals (Pet. App. 1a-11a) are reported at 270 F. 2d 954.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 20, 1959 (Pet. App. 8a). A petition for a rehearing, timely filed, was denied

on October 30, 1959. On January 28, 1960, the time in which to file a petition for a writ of certiorari was extended to and including March 28, 1960. The petition for a writ of certiorari was filed on March 28, 1960. The petitioner attempts to invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTION PRESENTED

Whether this Court has jurisdiction to review a decision by the United States Court of Customs and Patent Appeals, which affirmed the refusal of the Board of Appeals of the United States Patent Office to grant an application for a patent.

STATUTES INVOLVED

28 U.S.C. 1256 provides:

> *Court of Customs and Patent Appeals; certiorari.*
>
> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

28 U.S.C. 211 provides:

> *Appointment and number of judges.*
>
> The President shall appoint, by and with the advice and consent of the Senate, a chief judge and four associate judges who shall constitute a court of record known as the United States Court of Customs and Patent Appeals. Such court is hereby declared to be a court established under Article III of the Constitution of the United States.

35 U.S.C. 112 provides:

Specification.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. 145 provides:

Civil action to obtain patent.

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his

invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

STATEMENT

The petitioner seeks review of the denial of an application for a patent filed with the Commissioner of Patents. The application relates to "Improvements in and Relating to the Production of Energy through Nuclear Fission" (Pet. App. 1a). The petitioner's claims were rejected by the Commissioner and the Board of Appeals of the United States Patent Office primarily on the ground that the specification required by 35 U.S.C. 112 *(supra,* p. 3) was not satisfied in that the petitioner's claims are insufficient to enable those skilled in the art to make and use the invention (Pet. App. 4a). As a means of showing the operability and patentability of its invention, the petitioner, before the Court of Customs and Patent Appeals, sought to rely upon disclosures in two previous patent applications (Pet. App. 4a). The two previous patent applications, prosecuted by the petitioner's predecessor in title, the Alien Property Custodian (Pet. App. 6a-7a), had been rejected on the ground that they too did not contain disclosures sufficient to meet the requirements of R.S. 4888 (now 35 U.S.C. 112) and those rejections were affirmed by the Board of Appeals (Pet. App. 3a-4a). No appeal

to the court below was taken from those determinations and the petitioner's suit in the district court under 35 U.S.C. 145, *supra*, p. 3, for a determination of the merits of its prior patent applications was not timely commenced (Pet. App. 4a; 15a).[1] Because of final and binding adjudications as to the insufficiencies of the prior applications, the court below held that the prior disclosures could not be used to introduce an operative disclosure in the application then before it (Pet. App. 5a). Independent of the prior disclosures, the court held that the petitioner's specification "is entirely devoid of any recitation of methods or means of making the alleged invention operable" (Pet. App. 7a). Accordingly, because the petitioner's application "does not comply with the provisions of 35 U.S.C. 112" (Pet. App. 7a), the decision of the Board of Appeals was affirmed on July 20, 1959. The petitioner's timely motion for a rehearing was denied on October 30, 1959 (Pet. 9). Following the decision by the Court of Appeals, the petitioner sought leave to file a petition for rehearing out of time. This request was rejected by the court below on March 8, 1960 (Pet. 9-10).

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[1] On January 21, 1960, the Court of Appeals for the District of Columbia Circuit, reversing in part the judgment of the district court, held that the district court had jurisdiction to review, for arbitrariness or capriciousness, a decision of the Commissioner of Patents refusing, under 35 U.S.C. 133, to revive the two prior patent applications. The Court of Appeals and the district court were, however, in agreement that the district court, under 35 U.S.C. 145 (*supra*, p. 3), was without jurisdiction to consider the merits of the prior patent applications (Pet. App. 12a-18a; *Commissariat a L'Energie Atomique* v. *Robert C. Watson, Commissioner of Patents*, 274 F. 2d 594).

ARGUMENT

The question of whether the petitioner's application to the Patent Office disclosed a patentable invention is essentially one of fact and within the peculiar expertise of the court below. We submit that the decision below is correct and does not involve a question warranting review by this Court.[2] The petition should, however, be denied on jurisdictional grounds.

In *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693, the Court held that decisions of the Court of Appeals of the District of Columbia on appeal from decisions of the Patent Office in patent and trademark applications were not reviewable by this Court because such a decision is not a judicial judgment but is "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. 698-699. Hence, such a decision was not a justiciable case or controversy and was beyond the constitutional power of this Court to review.

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[2] In view of the limited scope of the decision of the Court of Appeals for the District of Columbia on January 21, 1960 (*supra*, n. 1, p. 5), the court below did not abuse its discretion in denying the petitioner leave to file, out of time, a petition for rehearing based upon the decision of the Court of Appeals. Similarly, there was no impropriety in the court below taking notice of the fact that the two prior patent applications, relied upon by the petitioner, had been rejected for insufficient disclosures. In any event, these questions clearly are not of such importance as to warrant review by this Court.

The jurisdiction of the Court of Appeals for the District of Columbia over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1-4, 45 Stat. 1475. But the nature of the proceeding was not changed, and thereafter, in denying certiorari in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction" and cited the *Postum Cereal* case.

In the present proceeding, the petitioner invokes 28 U.S.C. 1256, *supra*, p. 2, to sustain the Court's jurisdiction (Pet. 2). Section 1256 is part of the Act of June 25, 1948, 62 Stat. 683, codifying Title 28 of the United States Code. Prior to that codification, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was a provision relating to customs cases.[3] That provision was Section 195 of the old Judicial Code as amended.[4] Section 195 comprised

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[3] Summary appeals from the decisions of the Board of Appeals of the Patent Office to the Court of Customs and Patent Appeals in patent matters are to be distinguished from appeals taken to the Court of Customs and Patent Appeals from judgments of the United States Customs Court. Clearly, the latter are judicial in character and are reviewable by this Court. See, *e.g.*, *Barr* v. *United States*, 324 U.S. 83.

[4] Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

two elements, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases, and a second authorizing this Court to review such decisions. It did not refer to patent or trademark matters. The codification of Title 28 merely separated the foregoing two provisions, placing the former in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256.[5] Nothing in the codifying Act of 1948 or in its history suggests that Congress had any intention of giving this Court the power to review a class of cases over which jurisdiction had previously been withheld or to supersede the holding in the *Postum Cereal* case.[6] Stern and Gressman, *Supreme Court Practice* (2d ed., 1954), pp. 47-50. And since the enactment into positive law of Title 28, United States Code, this Court has denied certiorari in at least the following cases where the petitioners, in patent and trademark matters, invoked Section

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[5] The Reviser's Notes to Sections 1256 and 1541 confirm this derivation of those provisions.

[6] The same is true of the 1958 amendment to 28 U.S.C. 211 (*supra*, p. 2), P.L. 85-755, 72 Stat. 848, relied upon by petitioner (Pet. 11-12), which obviously does not remedy the jurisdictional defect inherent in this case:

> [T]he purpose and effect of the bill [H.R. 7866], as amended, is to integrate the Court of Customs and Patent Appeals into the constitutional system of Federal courts and to make its judges, both active and retired, available for assignment when and as their services are needed to meet congested calendars in other courts just as has already been done in the case of the Court of Claims and the Customs Court. [S. Rept. No. 2309, 85th Cong., 2d Sess., p. 5; see also, H. Rept. No. 2349, 85th Cong., 2d Sess.]

1256 as the jurisdictional authority of the Court and where the respondent's brief in opposition urged a lack of jurisdiction:[7] *Campbell* v. *Commissioner of Patents*, No. 300, October Term, 1954, certiorari denied, 348 U.S. 858; *Martin* v. *Commissioner of Patents*, No. 130, October Term, 1952; certiorari denied, 344 U.S. 824; *Shackell* v. *Marzall*, No. 763, October Term, 1951, certiorari denied, 343 U.S. 978; *Thompson* v. *Learned*, No. 496, October Term, 1951, certiorari denied, 342 U.S. 942; *Dalton & Cooley* v. *Marzall*, No. 87, October Term, 1951, certiorari denied, 342 U.S. 818; *Ducci* v. *Commissioner of Patents*, No. 603, October Term, 1955, certiorari denied, 350 U.S. 982; *Tatincloux* v. *Commissioner of Patents*, No. 734, October Term, 1955, certiorari denied, 351 U.S. 907; *Rubenfield* v. *Robert C. Watson, Commissioner of Patents*, No. 622, October Term, 1959, certiorari denied, February 29, 1960.

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[7] The jurisdiction exercised by the Court in *Hoover Co.* v. *Coe*, 325 U.S. 79, and *Special Equipment Co.* v. *Coe*, 324 U.S. 370, involved certiorari to the Courts of Appeals under 28 U.S.C. 1254. Those cases have no application here. Cf. Pet. 11.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied on jurisdictional grounds.

Respectfully submitted,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 826

COMMISSARIAT A L'ENERGIE ATOMIQUE, Assignee of Patent Applications of JEAN HENRY HALBAN, JEAN FREDERIC JOLIOT and LEW KOWARSKI, *Petitioner*

v.

ROBERT C. WATSON, Commissioner of Patents, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Customs and Patent Appeals

REPLY MEMORANDUM FOR PETITIONER

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May 6, 1960

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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REPLY MEMORANDUM FOR PETITIONER

Petitioner or its assignors have received patents in most countries of the world on the inventions here involved—inventions which relate to one of the most far reaching technological developments in the history of man. In the United States, however, they have consistently been unable to obtain a determination of their

claims on their real merits. Instead, they have been confronted with a never-ending series of procedural, technical and jurisdictional objections.

In these circumstances, for respondent to oppose certiorari on the ground that the decision below "is essentially one of fact" (Br. in Opp., p. 6) is less than candid. Petitioner seeks certiorari for the very reason that the court below did not consider and decide the relevant facts, but rested its decision on a misapplication of the doctrine of *res judicata,* which was held to preclude inquiry into facts otherwise relevant. If this Court has jurisdiction to issue the writ, the case is clearly one which warrants exercise of the jurisdiction.

As the Brief in Opposition makes plain, the question of this Court's jurisdiction to issue a writ of certiorari to the Court of Customs and Patent Appeals in patent and trademark cases* is itself an important question which deserves full consideration by this Court upon brief and oral argument.** Although the Government asserts that the issue was disposed of by the *California Fig Nut* case, decided in 1927, the issue continues to arise. The Government has cited no less than 8 petitions for certiorari in 10 years presenting the question, all of which have been denied without indication from the Court whether the denial rested on jurisdictional grounds or on the merits. Moreover, this Court has never considered the effect, on the question of jurisdiction, of the provision of the 1958 Judicial Code, accord-

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* There is no doubt of its jurisdiction to do so in customs cases.

** Petitioners suggest that such consideration could appropriately be given, either by postponing the question of jurisdiction to the merits, or by setting the matter down for further briefing and oral argument on the petition.

ing to Court of Customs and Patent Appeals the status of a constitutional court, or the 1948 revision of the Judicial Code providing, without qualification or limitation, that "cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

Above all, it is significant that the Government cites no consideration of logic or policy in support of its assertion that decisions of the Court of Customs and Patent Appeals in patent and trademark cases constitute an exception to this Court's general jurisdiction to review the decisions of inferior federal courts. Such asserted exception cannot rest in the nature of the court, which has been declared by Congress to be a constitutional court and whose decisions in other areas are reviewable by writ of certiorari. Nor can it rest in the nature of the issues, for exactly the same issues are reviewable by this Court when they arise in an action brought in the United States District Court under 35 U.S.C. § 145. Congress has provided two parallel routes for review of decisions of the Patent Office denying a patent in whole or in part. The effect of the Government's contention is that a litigant who chooses review by the Court of Customs and Patent Appeals under 35 U.S.C. § 141 must thereby forego any possibility of review by this Court, whereas one who chooses review by the District Court under 35 U.S.C. § 145, preserves the possibility of such review. No reason is, or can be, suggested for such an anomaly.

The effect of the asserted exception is to weaken this Court's authority to supervise the course of decision of federal courts and to resolve conflicts between them. In the Government's view, if a direct conflict should arise between a United States Court of Appeals and

the Court of Customs and Patent Appeals on a question of interpretation of the patent laws,* this Court would have power to review and correct the decision of the Court of Appeals and not that of the Court of Customs and Patent Appeals. And if an unseemly conflict of jurisdiction or practice should arise between such courts, this Court can review the actions of one party to the conflict and not the other.

The present case vividly illustrates the difficulties thereby created. It reflects a disagreement between the Court of Appeals for the District of Columbia—which regards the decisions in Cases I and II as subject to reconsideration—and the Court of Customs and Patent Appeals—which regards them as finally foreclosed. It reflects a clear failure on the part of the Court of Customs and Patent Appeals to give proper respect to the decision of the Court of Appeals. In this situation the Government's view is that this Court has power to deal with only one of the two courts involved. It could have revised and corrected the decision of the Court of Appeals had a petition been timely filed seeking review of that decision; but it has no authority to revise and correct the decision of the Court of Customs and Patent Appeals. This stultifying position, we submit, should be sustained only if compelled by the most explicit and unequivocal statu-

* In *Application of Blaisdell*, 242 F. 2d 779 (C.C.P.A. 1957) and *Watson* v. *Allen*, 254 F. 2d 342 (App. D.C. 1958) the two courts reached opposite conclusions on the identical facts as to whether certain activities constituted a public use which barred issuance of a patent. In the *Allen* case the Court of Appeals for the District of Columbia stated at p. 347, "Our holding with respect to public use cannot be reconciled with that of the Court of Customs and Patent Appeals." Certiorari was not applied for in either case.

tory language; here the statute (28 U.S.C. § 1256) on its face affirmatively refutes the Government's contention.

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